

DETAILED ACTION

Response to Amendment

1. This action is in response to the provisional election mailed December 20, 2007.

Claim 11 was amended rendering claims 11-16 and 18-25 pending.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections – 35 USC 112, first paragraph

3. Claims 11-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the instant claims or specification teaches how much starch content is in a coupon, which makes it difficult to determine how much starch content is in a non-authentic paper, as claim 11 teaches a non-authentic paper has a starch content similar to the coupon.

Claim Rejections – 35 USC 112, second paragraph

4. Claims 11-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In instant claim 11, the phrase, “non-authentic paper, having a starch content similar to the coupon” is indefinite. It is unclear how much starch content is in the non-authentic paper, as there is no specific starch content taught for the coupon.

In instant claim 11, it is unclear what the first material is.

Claim Rejections – 35 USC § 102(b)

5. Claims 11-14, 16, 18-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahlm, Jr. et al (U.S. 3,001,887).

Ahlm, Jr. discloses verifying the authenticity of a coupon having a surface printed with an indistinguishable material (first material) which will form initially colorless and inherently authenticating words, symbols or designs adapted to be developed in color upon the application of certain chemical agents (column 1, lines 9-45 and 55-65). Because Ahlm, Jr. discloses an indistinguishable material (first material), which will form initially colorless and inherently authenticating words, symbols or designs adapted to be developed in color upon the application of certain chemical agents (column 1, lines 9-45 and 55-65), it is inherent for the first material to have a lower starch content, or be free from starch, in comparison to the coupon, as it meets the limitations of (a), (b) and (c) in

claim 11. Additionally, on page 6, of Applicant's remarks, in paragraph 2, Applicant states on the record, that "typical paper, such as coupons, includes starch." Because the indistinguishable material is authenticated by chemical agents, but the coupon is not, it is inherent that a lighter mark would result from an interaction between the first material and chemical and a darker mark would result from an interaction with the coupon portion lacking the first material and a chemical composition, as in claims 11, 16, 20-21, 23 and 25. In claim 11, the phrase, "operable to interact with a non-authentic paper" is constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Ahlm Jr. discloses the indistinguishable material is coated on the coupon (column 1, lines 50-60) as in claim 12. The drawing of Ahlm Jr. shows a pattering of the first material on the coupon, as in claims 13 and 22. Because Ahlm Jr. is silent of trace chemical residual on the coupon, the applied indistinguishable material (first material coating) has no trace chemical residual on the coupon, as in claims 14 and 18.

Concerning claim 19, it is inherent to redeem or avoid redemption of the coupon based upon an application of the authenticating mark.

Claim Rejections – 35 USC § 103(a)

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlm, Jr. et al (U.S. 3,001,887) in view Kurrle (U.S. 6,214,766).

Ahlm, Jr. is relied upon for instant claims 11, 20 and 21. Ahlm, Jr. does not explicitly disclose the printing process for applying the coated material to be a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process. Ahlm, Jr. and Kurrle are both directed to verifying the authenticity of a paper product. It would have been obvious to one of ordinary skill in the art to have applied the coated printed material using flexography, as taught in Kurrle, in the paper or coupon of Ahlm, Jr. to produce an improved layer of material on the surface of the paper, which will not readily come off the surface.

Claim Rejections – 35 USC § 102(b)

7. Claims 11-16, 18-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawashima (U.S. 5,415,434).

Kawashima discloses a printed matter (coupon) with a color developing area having a coloring compound (first material) that is changed from a colorless to colored state by application of a color coupling additive (column 1, lines 5-68 and Figure 1). Because Kawashima discloses a coloring compound (first material), that is changed from a colorless to colored state by application of a color coupling additive, it is inherent for the first material to have a lower starch content, or be free from starch, in comparison to the coupon, as it meets the limitations of (a), (b) and (c) in claim 11.

Additionally, on page 6, of Applicant's remarks, in paragraph 2, Applicant states on the record, that "typical paper, such as coupons, includes starch." Because the coloring compound is changed from a colorless to colored state by application of a color coupling additive, but the coupon is not, it is inherent that a lighter mark would result from an interaction between the first material and chemical and a darker mark would result from an interaction with the coupon portion lacking the first material and a chemical composition, as in claims 11-12, 16, 20-21, 23 and 25. In claim 11, the phrase, "operable to interact with a non-authentic paper" is constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

Concerning claims 13 and 22, Kawashima shows a pattering of the first material on the coupon in Figure 1.

Concerning claim 15, Kawashima further discloses the color applicator can be marked with a pen (column 7, lines 6-11).

Concerning claims 14 and 18, because Kawashima is silent of trace chemical residual on the coupon, the applied coloring compound (first material coating) has no trace chemical residual on the coupon.

Concerning claim 19, it is inherent to redeem or avoid redemption of the coupon based upon an application of the authenticating mark.

Claim Rejections – 35 USC § 103(a)

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima (U.S. 5,415,434) in view Kurrle (U.S. 6,214,766).

Kawashima (U.S. 5,415,434) is relied upon for instant claims 11, 20 and 21. Kawashima (U.S. 5,415,434) does not explicitly disclose the printing process for applying the coated material to be a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process. Kawashima (U.S. 5,415,434) and Kurrle are both directed to verifying the authenticity of a paper product. It would have been obvious to one of ordinary skill in the art to have applied to coated printed material using flexography, as taught in Kurrle, in the paper or coupon of Kawashima (U.S. 5,415,434) to produce an improved layer of material on the surface of the paper, which will not readily come off the surface.

Response to Arguments

9. Applicant's arguments of the claims rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement have been considered and have overcome the rejection by cancelling the phrase, "non-currency grade paper forming". However, a new rejection under 35 U.S.C. 112, first paragraph,

has been made over the newly amended limitation of "non-authentic paper, having a starch content similar to the coupon" as it is unclear how much starch content is in the non-authentic paper, as there is no specific starch content taught for the coupon.

Applicant argues the relational nature of non-authentic paper or non-currency paper and the starch content in comparison to a coupon or first material. Applicant further argues ten references were submitted in response to the Office Action dated March 22, 2007 and Advisory Action dated June 13, 2007. Although Applicant submitted said references, it remained inconclusive how much starch content was in non-authentic paper or non-currency paper. Regarding the action dated September 20, 2007, it was rendered that the starch content of the coupon was lower than non-currency grade paper, because the reference did not indicate the paper had a starch content.

However, Examiner acknowledges Applicant's admission that typical paper, such as used in coupons, includes starch, although it is unsubstantiated.

New rejections under 35 U.S.C. 112, second paragraph, have been made and the rejection made because it is unclear what the first material is has been maintained as Applicant has failed to address this rejection.

Applicant argues claim 25 was not considered or discussed in the office action dated September 20, 2007. Claim 25 was considered in the Ahlm, Jr. et al and Kawashima (U.S. 5,415,434) rejections; therefore, it was considered in the office action dated September 20, 2007.

Applicant argues the amount of starch in the first material and coupon are clearly defined. In claim 25, a first material being substantially free of starch is not clearly defined, as it remains unclear if the first material has starch or not.

Applicant argues Ahlm, Jr et al fails to disclose a first material having a lower starch content than the coupon. Because Ahlm, Jr. discloses an indistinguishable material (first material), which will form initially colorless and inherently authenticating words, symbols or designs adapted to be developed in color upon the application of certain chemical agents (column 1, lines 9-45 and 55-65), it is inherent for the first material to have a lower starch content, or be free from starch, in comparison to the coupon, as it meets the limitations of (a), (b) and (c) in claim 11.

Applicant further argues Kawashima fails to disclose a first material having a lower starch content than the coupon. Because Kawashima discloses a coloring compound (first material), that is changed from a colorless to colored state by application of a color coupling additive, it is inherent for the first material to have a lower starch content, or be free from starch, in comparison to the coupon, as it meets the limitations of (a), (b) and (c) in claim 11.

Applicant argues Ahlm, Jr. et al fails to disclose a light mark results from interaction between the first material and the chemical. Because the indistinguishable material is authenticated by chemical agents, but the coupon is not, it is inherent that a lighter mark would result from an interaction between the first material and chemical and a darker mark would result from an interaction with the coupon portion lacking the first material and a chemical composition, as in claim 11.

Applicant further argues Kawashima fails to disclose a light mark results from an interaction between the first material and the chemical. Because the coloring compound is changed from a colorless to colored state by application of a color coupling additive, but the coupon is not, it is inherent that a lighter mark would result from an interaction between the first material and chemical and a darker mark would result from an interaction with the coupon portion lacking the first material and a chemical composition, as in claim 11.

Applicant argues both references fail to disclose a chemical that is operable to interact with a non-authentic paper, having a starch content and not having the first material. The phrase, "operable to interact with a non-authentic paper" is constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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